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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,341	01/10/2001	Robert M. Gruber	82552	2235

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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/760,341

Applicant(s)

GRUBER, ROBERT M.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

- 1) Applicant's amendment filed September 13, 2004 has been entered.
- 2) Applicant's arguments filed September 13, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the computer networked system is only intended to allow a user to purchase products for the Federal Government using only DOD purchasing documents and the Government Bankcard (e.g. Claim 1), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The modified Quelene discloses a computer system comprising:

means used by a requester to create a purchase document (see Fig. 2A and the description thereof);

first notifying means for notifying a processor of the document, wherein the processor reviews the document for completeness and accuracy and upon finding, the processor forwards the document to the approval chain (see Figs. 2A-2C and col. 2, line 65 – col. 3, line 57; col. 8, line 49 – col. 12, line 44; col. 15, line 17 – col. 16, line 3);

means for determining the approval chain for the document (see Id.);

means for sending the document through the chain, wherein each of the signatories approves the document by affixing an electronic signature to the document before the document is forwarded to a next signatory in the chain for approval (see Figs. and col. 2, line 65 – col. 3, line 57; col. 8, line 49 – col. 12, line 44; col. 15, line 17 – col. 16, line 3);

second notifying means for notifying the processor of approval of the purchase document by the chain, wherein the processor is notified after a final signatory in the approval chain approves the document (see Id.); and

means for printing an approved government purchase document (see *Infra* rejection).

Because the modified Quelene's structure is capable of performing the intended use, it meets the claim.

Additionally, the newly added limitations in the preamble have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action

Claim Objections

- 4) Claims 18-20 are objected to because of the following informalities:

In Claim 18, line 23, --;-- should be inserted after "document".

In Claim 18, line 44, "and" should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

- 5) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 6) Claims 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 15, lines 47-50; and Claim 18, lines 56-59, respectively, the invention are incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: any means for selecting a sole source for the purchase of the item so as to justify the purchase of the item without price competition from multiple vendors. For example, the claim would include means for comparing prices of one source with others to select the specific source for the purchase. Without showing how the requestor has come to determine which sole source to provide without price competition from multiple vendors, any arbitrary selection by the requestor would be approved by the government agency and

there is clearly a potential abuse of this system by any requestor without providing adequate explanation how to select this sole source.

Claim Rejections - 35 USC § 103

7) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8) Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quelene (US 6,453,306).

As for Claim 1, Quelene discloses a system comprising:

means used by a requester to create a purchase document (see Fig. 2A and the description thereof);

first notifying means for notifying a processor of the document, wherein the processor reviews the document for completeness and accuracy and upon finding, the processor forwards the document to the approval chain (see Figs. 2A-2C and col. 2, line 65 – col. 3, line 57; col. 8, line 49 – col. 12, line 44; col. 15, line 17 – col. 16, line 3);

means for determining the approval chain for the document (see Id.);

means for sending the document through the chain, wherein each of the signatories approves the document by affixing an electronic signature to the document before the document is forwarded to a next signatory in the chain for approval (see Figs.

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and col. 2, line 65 – col. 3, line 57; col. 8, line 49 – col. 12, line 44; col. 15, line 17 – col. 16, line 3); and

second notifying means for notifying the processor of approval of the purchase document by the chain, wherein the processor is notified after a final signatory in the approval chain approves the document (see *Id.*).

However, Quelene does not expressly disclose the invention including:

means for printing an approval form, wherein the form contains information relevant to the document and the signature of each of the signatories in the chain.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the system of Quelene to include means for printing the appropriate form at any level (requester, processor, etc.,) for the purpose of printing any document relevant to the transaction and maintaining the hardcopy of the necessary document as backup files in case of database failure.

The modified Quelene discloses the invention as recited above, but does not expressly disclose the system including the requester selecting the government purchase document to be created by the requester from a group of government Purchase documents consisting of a DD (Department of Defense) Form 1348 Six Part Requisition Document, a DD Form 1348-6 Requisition Document and a work sheet for a government Bankcard purchase.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the system of Quelene such that the system can be used for a government purchase document and approval of the government purchase document to enable the requester to select the document from a group of government purchase documents including the DD (Department of Defense) Form 1348 Six Part Requisition Document, a DD Form 1348-6 Requisition Document and a work sheet for a government Bankcard purchase because Applicant has not disclosed that selecting the specific documents including “the DD (Department of Defense) Form 1348 Six Part Requisition Document, a DD Form 1348-6 Requisition Document and a work sheet for a government Bankcard purchase” provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant’s invention to perform equally well with the modified system of Quelene because the modified Quelene’s structure includes the means to create the purchase document; first notifying means; means for determining the approval chain; means for sending the purchase document through the approval chain; second notifying means; and means for printing, and it would perform equally well the intended use as claimed by Applicant.

Therefore, it would have been an obvious matter of design choice to modify Quelene to obtain the invention as specified in claim.

As for Claim 2, the modified system of Quelene further discloses the system including means for rejecting the purchase document by any one of the signatories, wherein the processor and the requester are notified of the rejection of the government Purchase document, the Processor, in response to the rejection, requesting information from the requester to correct and complete the government purchase document. (see Figs. 2B-2C);

As for Claim 3, the modified system of Quelene further discloses the system including means for accessing all of the government purchase documents awaiting approval by each of signatories (see Figs. and col. 2, line 65 – col. 3, line 57; col. 8, line 49 – col. 12, line 44; col. 15, line 17 – col. 16, line 3);

As for Claim 4, the modified system of Quelene further discloses the system including means for illustrating the approval chain, wherein an indicator is provided as each of the signatories approves the purchase document (see Id.); and

As for Claim 6, the modified system of Quelene further discloses the system including means for completing the document, wherein the system searches a database of existing purchase documents after the requester inputs a new part number which corresponds to an existing part number in the database (see Figs. and col. 2, line 65 – col. 3, line 57; col. 8, line 49 – col. 12, line 44; col. 15, line 17 – col. 16, line 3).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

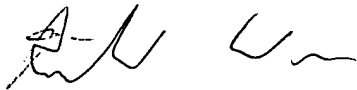
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Woo
Patent Examiner
Art Unit 3629
December 23, 2004



DENNIS RUHL
PRIMARY EXAMINER